

Docket No. F-8224

Ser. No. 10/823,919

**REMARKS****RECEIVED  
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Claims 3 and 5-12 remain pending in this application. Claims 3-12 are rejected. Claims 4 and 13-20 are cancelled herein. Claims 1 and 2 are previously cancelled. Claims 3, 6, 10 and 11 are amended herein to clarify the invention.

**CLAIM REJECTIONS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH,  
ENABLEMENT REQUIREMENT**

Claims 3-12 are rejected under 35 U.S.C. § 112, first paragraph, as not being enabled by the specification. Applicant herein respectfully traverses this rejection. The Office Action asserts that the step of cutting the exposed portion is critical or essential to the invention. The step of cutting the exposed portion is now included in claim 3. Therefore, reconsideration of the rejection and allowance of the claims are earnestly solicited.

**CLAIM REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

Claims 3-12 are rejected as indefinite under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter of the invention. The Office Action asserts that, with respect to claim 3, the use of the term "pressed portions" is indefinite because both the exposed portions and the active material impregnated portions are pressed.

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In claim 3 the term "pressed portions" is used to define an area formed by the press working recited in the claim. The claim recites that the press working forms a rail shaped protrusion above the pressed portions thus relating that the rail shaped protrusion is not included in the pressed portions. However, in order to further prosecution, the claim is now amended to recite that the press working step excludes the rail shaped protrusion. Thus, the claim is amended to clarify the "pressed portions" as excluding the rail to address the Examiner's concerns. Additionally, it will be noted that the "compressing" referred to in the claims is not used in relation to the pressed portions which already exist at the time of the compressing.

The Examiner further questions what determines a deviation when the boundary is adjacent to the impregnated region. It is submitted that the deviation referred to in the claim would be well understood by those skilled in the art to be a deviation of the junction of the exposed portions and the impregnated portions from an imaginary straight line drawn through a median of the junction. Since the junction may vary from straight, such measurements are routinely known to be an amount that the junction varies from either side of the imaginary straight line. As such, it is submitted that one skilled in the art would readily appreciate the metes and bounds of the claim.

Claim 4 is now cancelled rendering the rejection moot.

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Claim 6 is now amended to recite that the "half a thickness" is half a thickness of "an original thickness of said core substrate."

Claim 10 is rejected for its recitation of "impregnation density variation" because the Examiner believes that it is not clear "what defines the variation." The Examiner contends that since there are exposed portions "the variation is almost 100%." The "variation" in the claim is limited to the pressed portions. It is not consistent with the claim language to read the "pressed portions" on the core substrate exposed portion because the pressed portions are defined with respect to the press working step and the rail which forms the exposed portion is excluded from the press working. Thus, since the "pressed portions" are now clearly recited to be limited to the areas outside of the exposed rail, it is submitted that the claim is sufficiently definite.

In view of the above reasons, reconsideration of the rejection of claims 3 and 5-12 and their allowance are earnestly requested.

#### **CLAIM REJECTIONS UNDER 35 U.S.C. §§ 102 AND 103**

Claims 3-12 are rejected under 35 U.S.C. § 102(b) as being anticipated by, or as obvious over the Shigemoto reference under 35 U.S.C. § 103(a). The applicant herein respectfully traverses these rejections.

"Under 35 U.S.C. § 102, anticipation requires that each and every element of the claimed invention be disclosed in the prior art reference. ... In addition, the

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prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public." *Akzo N.V. v. U.S. International Trade Commission*, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987). "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP §706.02(j) "Contents of a 35 U.S.C. §103 Rejection". It is respectfully submitted that the cited references fail to disclose at least the following features and elements of the present invention.

Claim 3 is now amended to recite that "said core substrate exposed section and said exposed section cut sides extend along an entire longitudinal side of each of said first and second core substrate pieces." This configuration is not found in the Shigemoto reference. Instead, the Shigemoto reference discloses that active material is removed from a part 3 of the metal porous body and that a lead 5 is attached after the removal of the active material. This is clearly shown in Fig. 4.

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The area 3 of the Shigemoto reference does not extend along an entire length of a side. Therefore, the Shigemoto reference must fail as a ground of anticipation for claim 1.

Furthermore, the Shigemoto reference does not disclose a boundary between a core substrate exposed portion and an active material impregnated core substrate which extends the length of the substrate. Thus, the focus of the Shigemoto reference is not concerned with straightness of a boundary. However, in the presently claimed invention, the straightness of such a boundary affects the electrical properties of the resultant electrode. See specification at page 5. Therefore, the Shigemoto reference provides no teaching providing a straight boundary as claimed, that extends the length of the substrate and that deviates from straight no more than 0.2mm. As such, the reference cannot anticipate nor render obvious the claim.

The Examiner has correctly noted that the Shigemoto reference teaches a different method. The Shigemoto reference applies vibration to a portion of the impregnated substrate before press working is applied to the impregnated substrate, and then compresses the portion to which the vibration was applied. The present claim first requires press working to form the rail, then removing the active material from the rail by vibration, and finally compressing the rail to provide the straight boundaries. It is respectfully submitted that since the Shigemoto reference does not teach this process it cannot render obvious the claimed straight boundaries

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because it does not provide incentive to produce such straight boundaries and it does not enable such production. This means the present product of the claim is different from the product produced by the Shigemoto reference and hence nonobvious as a product. Even if one desired to produce a straight boundary as claimed, it is settled case law that mere desirability of a characteristic of a product cannot render a product obvious when the prior art does not teach nor render obvious a process to enable production of a product with the characteristic. *In re Irani*, 166 USPQ2d, 27 (CCPA 1970).

Thus, it is respectfully submitted that the rejected claims are not obvious in view of the cited reference for at least the reasons stated above and applicant does not concede to assertions of the Examiner not addressed herein. Reconsideration of the rejections of claims 3 and 5-12 and their allowance are respectfully requested.

#### REQUEST FOR EXTENSION OF TIME

Applicant respectfully requests a one month extension of time for responding to the Office Action. **The fee of \$120.00 for the extension is provided for in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.**

If there is any discrepancy between the fee(s) due and the fee payment authorized in the Credit Card Payment Form PTO-2038 or the Form PTO-2038 is missing or fee payment via the Form PTO-2038 cannot be processed, the USPTO

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is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,  
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